

TERMINAL DISCLAIMER TO OBVIATE A
DOUBLE PATENTING REJECTION
OVER A PRIOR PATENT

Docket Number

C1039-70021US01

In re Application of
Application No. **10/719,493**
Confirmation No.
Filed:
For:

Arthur M. Krieg *et al.*

10/719,493

3218

November 21, 2003

METHODS OF TREATING CANCER USING
IMMUNOSTIMULATORY OLIGONUCLEOTIDES

The owner, The United States of America as Represented by the Secretary, Department of Health and Human Services, of 1/3rd interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §154 to §156 and §173 as presently shortened by any terminal disclaimer, of prior Patent No. 6,653,292. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §154 to §156 and §173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. §1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☒ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☐ The undersigned is an attorney or agent of record.

Signature

Date

Typed or Printed Name

☒ Terminal disclaimer fee under 37 CFR 1.20(d) included.

*Statement under 37 CFR. 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP §324.

985215.1

03/07/2006 NNGUYEN1 00000021 232825 10719493

01 FC:1814

130.00 DA



PTO/SB/96 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

STATEMENT UNDER 37 CFR 3.73(b)Applicant/Patent Owner: University of Iowa Research Foundation et al.Application No./Patent No.: 10/719,493 Filed/Issue Date: November 25, 2003Entitled: METHODS OF TREATING CANCER USING IMMUNOSTIMULATORY OLIGONUCLEOTIDESUniversity of Iowa Research Foundation, a University
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or
2. ☐ an assignee of less than the entire right, title and interest.

The extent (by percentage) of its ownership interest is _____ %
in the patent application/patent identified above by virtue of either:

- A. ☒ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____.

OR

- B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.
2. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.
3. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

- ☐ Copies of assignments or other documents in the chain of title are attached.
[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

Signature_____
Date_____
Printed or Typed Name_____
Telephone Number_____
Title

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: March 1, 2006Signature: Helen C. Lockhart (Helen C. Lockhart)



PTO/SB/96 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

STATEMENT UNDER 37 CFR 3.73(b)Applicant/Patent Owner: University of Iowa Research Foundation et al.Application No./Patent No.: 6653292 Filed/Issue Date: November 25, 2003Entitled: METHODS OF TREATING CANCER USING IMMUNOSTIMULATORY OLIGONUCLEOTIDESUniversity of Iowa Research Foundation , a University
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or
2. ☐ an assignee of less than the entire right, title and interest.

The extent (by percentage) of its ownership interest is _____ %
in the patent application/patent identified above by virtue of either:

- A. ☒ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel _____ ,
Frame _____ .

OR

- B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at
Reel _____ , Frame _____ , or for which a copy thereof is attached.
2. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at
Reel _____ , Frame _____ , or for which a copy thereof is attached.
3. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at
Reel _____ , Frame _____ , or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

☐ Copies of assignments or other documents in the chain of title are attached.
[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

Signature_____
Date_____
Printed or Typed Name_____
Telephone Number_____
Title

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: March 1, 2006 Signature: Helen C. Lockhart (Helen C. Lockhart)

ASSIGNMENT

WHEREAS, I, Dennis Klinman, as an employee of the Department of Health and Human Services during which time co-invented "METHODS OF TREATING CANCER USING IMMUNOSTIMULATORY OLIGONUCLEOTIDES" for which has been made application for Letters Patent of the United States Serial No. 10/719,493 filed November 21, 2003; and

WHEREAS, I am an applicant named in the above-identified application for Letters Patent; and

WHEREAS, the conditions under which said invention was made are such as to entitle THE UNITED STATES OF AMERICA, as represented by the Secretary, Department of Health and Human Services [hereinafter THE GOVERNMENT] under Paragraph 1(a) of Executive Order 10096 to the entire right, title, and interest herein, both domestic and foreign; and

WHEREAS, THE GOVERNMENT is desirous of acquiring all domestic and foreign right, title, and interest in the above-mentioned invention described in the application for Letters Patent; and

NOW, THEREFORE, for good and valuable consideration, the receipt of which is hereby acknowledged, I hereby assign and transfer to THE GOVERNMENT, represented by the Secretary, Department of Health and Human Services, the full and exclusive rights in and to said invention in the United States and within each and every foreign country in which THE GOVERNMENT elects to file and the entire right, title, and interest in and to such applications, and any continuations, continuations-in-part, divisions, reissues or extensions thereof, and including priority rights as may be filed in the United States and foreign countries, and such Letters Patent as may be granted to be held by THE GOVERNMENT to the end of the term for which the same would have been held by the inventor had this assignment not been made.

I further agree to make, execute, and deliver to the Secretary, Department of Health and Human Services, upon request, any and all papers, documents, affidavits, or other instruments that may be necessary in the prosecution of any application or applications for improvements or reissues of Letters Patent, and to assist THE GOVERNMENT in every way as may be requested in protecting said invention, provided that any expense of extending such assistance shall be paid by THE GOVERNMENT.

IN WITNESS WHEREOF I subscribe my hand and seal on the dates shown below:

Feb 28, 06
 Date _____
 County of Prince Georges
 State of Maryland

Dennis Klinman

Subscribed and sworn to before me this 28th day of Feb, 2006.
 [Seal]

Ingrid G. Harris
 Notary Public INGRID G. HARRIS
 NOTARY PUBLIC STATE OF MARYLAND
 My Commission Expires August 21, 2007